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Docket No. 0514-1047-1
PATENT
MAILSTOP AF

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Pierre HOLZSCHUH et al. Conf. 4719

Application No. 10/612,972 Group 1761

Filed July 7, 2003 Examiner A. O. Pearse

PROCESS FOR THE PRODUCTION OF FOODSTUFF SMOKE
BY PYROLYSIS, USE OF A REACTOR PARTICULARLY
ADAPTED TO SAID PROCESS, SMOKE AND SMOKED
FOODSTUFFS THUS OBTAINED

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

February 8, 2007

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

A Notice of Appeal is filed herewith.

The review is requested for the reasons advanced on the attached sheets:

Respectfully submitted,

YOUNG & THOMPSON

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REASONS IN SUPPORT OF REQUEST FOR REVIEW

A pre-appeal brief request for review is respectfully requested because the rejections of the independent claims include a clear factual error and legal error, as explained below.

Claims 17-34 Would Not Have Been Obvious Under 35 USC 103(a) in View of UNDERWOOD et al. and WISTREICH et al.

Claims 17-34 are directed to a foodstuff smoke and a process for the production of a foodstuff smoke by pyrolysis. Claims 17 and 30 are the only independent claims under consideration. Claim 17 recites a process for the production of smoke adapted for smoking foodstuffs, wherein the smoke is obtained by pyrolysis of an organic material. Claim 30 recites a process for producing liquid smoke flavor.

Underwood et al disclose an aqueous wood smoke solution for flavoring foodstuffs. The aqueous wood smoke solution is produced by heating ground wood or cellulose in an oxygen starved atmosphere to between 400°C and 650°C.

However, Underwood et al neither disclose nor suggest heating organic material by directly heating and vibrating an ascending tubular element or elements to produce a pyrolysis reaction as recited in the independent claims. At col. 8, lines 55-60, Underwood et al state that a

"fast pyrolysis of wood is initiated in the thermal mixer (1) and continues in a transport reactor (9). The transport reactor is a length of pipe which is housed in an electrical oven (10). The mixture of hot gases and biomass passes from the thermal mixer (1), through the transport reactor (9), to the quencher (2) and to the solids separator (23)."

Thus, while UNDERWOOD et al utilize a length of pipe, the length of pipe is placed in an electrical oven and heated indirectly. The heating step that utilizes the heating coils disclosed by UNDERWOOD et al. cannot be compared to the heating step recited in the claimed invention. The heating coils disclosed by UNDERWOOD et al are an indirect heat source. Independent claims 17 and 30 state that the organic material is directly heated by the tubular element or elements.

Indirect heating means are avoided because the intermediate element between the heating means and the product (e.g., wood) to be pyrolyzed introduces a temperature shift between the temperature of the heating means and the temperature of the wood. This makes it difficult to control the temperature of the wood in real time. Indeed, overheating can occur that directly affects the quality of the smoke that is produced.

As to the claimed invention, the temperature of the wood can be controlled so that it is the same as of the heating means (e.g., example 2). If the temperature of the wood changes (e.g., due to chemical reactions), the system immediately compensates this by adjusting the electrical power provided to the heating means, thereby allowing the temperature to be precisely regulated.

Thus, UNDERWOOD et al neither disclose nor suggest directly heating or vibrating an ascending tubular element or elements to produce a pyrolysis reaction. In imposing the rejection, the Official Action also acknowledges that UNDERWOOD et al fail to a vibratory element, a step of preheating, a step of condensing smoke product, a re-injection step, and the amount of

benzoanthracene that is disclosed. In an effort to remedy the deficiencies of UNDERWOOD et al for reference purposes, the Official Action cites to WEISTRICH et al.

WEISTRICH et al. disclose a liquid smoke and a method for making the liquid smoke. Hardwood, in finely divided particulate form, is fed continuously from a hopper 12 to form a layer 14 on a metal plate 16, in the form of a vibratory conveyor for advancement of the particulate material through an enclosed space 18 heated to a temperature sufficient to cause thermal destruction or degradation of the wood particles. The bottom side of the plate 16 is heated, directly or indirectly, as by a flame, at an elevated temperature of about 600 °C to 750 °C (col 2, lines 40-50 and Fig.1).

Accordingly, WISTREICH et al utilize a method that requires a flat conveyor. WISTREICH et al do not disclose or suggest an ascendant tubular element with a lower/upper.

A clear factual error exists in that neither publication suggests an ascending tubular element or elements to produce a pyrolysis reaction. In fact, the Official Action does not address this recitation. While claim 18 does recite that the tubular element or elements are given a vibratory movement having a horizontal and/or vertical component, it is the vibratory movement itself that has a horizontal and/or vertical component, not the tubular element or elements.

As UNDERWOOD et al disclose a process that relies on indirectly heating a pipe that is placed in an electrical oven, it is believed that one skilled in the art would be dissuaded from combining the teachings of WISTREICH et al, which disclose the

importance of a flat conveyor. In this regard, it is believed that a clear legal error exists in that one skilled in the art would lack the motivation to combine and modify the publications to obtain the claimed invention.

Applicants also respectfully submit that the Official Action fails to show that one skilled in the art would expect the benzoanthracene would in an amount as recited in the claims. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). There is no indication that the processes disclosed by UNDERWOOD et al or WISTREICH et al would inherently provide this feature. Thus, it is believed that the Official Action fails to satisfy its burden in showing that the recitation would be expected or present.

The Double Patenting Rejection of Claims 19-34 Should Not Prevent the Allowance and Passage to Issue of the Present Application.

Claims 1-16 were provisionally rejected on the grounds of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-15 of copending Application No. 10/765,123.

However, the rejection is a "provisional" nonstatutory obviousness-type double patenting rejection. As set forth in MPEP

\$804, if a "provisional" nonstatutory obviousness-type double patenting rejection is the only rejection remaining in the earlier of the two pending applications, while the later-filed application is rejected on other grounds, the Examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

Thus, as the obviousness rejection should be withdrawn for the reasons noted above and there no other issues remaining, applicants respectfully request that the present application be allowed without a terminal disclaimer.

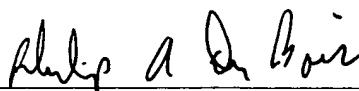
Conclusion

The above discussion is believed to show that the final rejection as formulated in the Official Action of September 8, 2006, would not be sustained if reviewed by the Board.

It is therefore believed that the rejections should be withdrawn and the present application allowed short of formal appeal to the Board.

Respectfully submitted,

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